EXHIBIT 3

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Part III

Department of Commerce

United States Patent and Trademark Office

37 CFR Part 1

Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

RIN 0651–AB13

Request for Continued Examination Practice and Changes to Provisional Application Practice

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases to implement certain provisions of the American Inventors Protection Act of 1999. These provisions of the American Inventors Protection Act of 1999: Provide for continued examination of an application for a fee; extend the pendency of a provisional application if the date that is twelve months after the filing date of the provisional application falls on Saturday, Sunday, or a Federal holiday within the District of Columbia; eliminate the copendency requirement for a nonprovisional application to claim the benefit of a provisional application; provide for the conversion of a provisional application to a nonprovisional application; and provide a prior art exclusion for certain commonly assigned patents.

EFFECTIVE DATE: August 16, 2000.

FOR FURTHER INFORMATION CONTACT: Robert W. Bahr, Karin L. Tyson, or Robert A. Clarke by telephone at (703) 308–6906, or by mail addressed to: Box Comments—Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872–9411, marked to the attention of Robert W. Bahr.

SUPPLEMENTARY INFORMATION: The American Inventors Protection Act of 1999 (Title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948) as introduced in the 106th Congress on November 17, 1999) was incorporated and enacted into law on November 29, 1999, by § 1000(a)(9), Division B, of Pub. L. 106–113, 113 Stat. 1501 (1999). The American Inventors Protection Act of 1999 contains a number of changes to title 35, United States Code. The United States Patent and Trademark Office (Office) published an interim rule revising the rules of practice to implement the provisions of §§ 4403, 4801, and 4807 of the American Inventors Protection Act of 1999. *See Changes to Application Examination and Provisional Application Practice,* Interim Rule, 65 FR 14865 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47 (Apr. 11, 2000). This notice adopts final changes to the rules of practice to implement these provisions of the American Inventors Protection Act of 1999.

Section 4403 of the American Inventors Protection Act of 1999 is effective on the date six months after the date of enactment of the American Inventors Protection Act of 1999 (May 29, 2000) and applies to applications (other than for a design patent) filed on or after June 8, 1995. Section 4801 of the American Inventors Protection Act of 1999 is effective on the date of enactment of the American Inventors Protection Act of 1999 (November 29, 1999) and applies to all provisional applications (with limited exception) filed on or after June 8, 1995. Section 4807 of the American Inventors Protection Act of 1999 is effective on the date of enactment of the American Inventors Protection Act of 1999 (November 29, 1999) and applies to all applications filed on or after November 29, 1999.

Section 4403 (Continued Examination of Patent Applications): Section 4403 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 132 to state that the Office ''shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant,'' and that the Office ''may establish appropriate fees for such continued examinations and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under [35 U.S.C. 41(h)(1)].'' Previously, an applicant had to file a continuing application (a continuing application under § 1.53(b) or a continued prosecution application under § 1.53(d)) to obtain continued examination of an application for a fee (the application filing fee). Section 4403 of the American Inventors Protection Act of 1999 will provide statutory authority for the continued examination of an application for a fee (to which the small entity reduction will be applicable) without requiring the applicant to file a continuing application.

Section 4801 (Provisional Applications): Section 4801(a) of the American Inventors Protection Act of 1999 amends 35 U.S.C. 111(b)(5) to provide that ''[n]otwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under [35 U.S.C. 111(a)]'' but that if ''no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival * * *.'' Thus, § 1.53(c) is amended to provide both for the conversion of a provisional application (35 U.S.C. 111(b) and § 1.53(c)) to a nonprovisional application (35 U.S.C. 111(a) and § 1.53(b)), and for the conversion of a nonprovisional application (35 U.S.C. 111(a) and § 1.53(b)) to a provisional application (35 U.S.C. 111(b) and § 1.53(c)).

Section 4801 of the American Inventors Protection Act of 1999 contains no provision for according the resulting nonprovisional application a filing date other than the original filing date of the provisional application. Thus, under the patent term provisions of 35 U.S.C. 154, the term of a nonprovisional application resulting from the conversion of a provisional application pursuant to 35 U.S.C. 111(b)(5) will be measured from the original filing date of the provisional application (which is the filing date accorded the nonprovisional application resulting from conversion under § 4801 of the American Inventors Protection Act of 1999). Applicants are strongly cautioned to consider the patent term implications of converting a provisional application into a nonprovisional application pursuant to 35 U.S.C. 111(b)(5), rather than simply filing a nonprovisional application within twelve months of the provisional application's filing date and claiming the benefit of the provisional application under 35 U.S.C. 119(e).

Section 4801(b) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(e) to provide that ''[i]f the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.''

Section 4801(c) of the American Inventors Protection Act of 1999 also amends 35 U.S.C. 119(e) to eliminate the requirement that a provisional application be pending on the filing date of the nonprovisional application for the nonprovisional application to claim the benefit of the provisional application.

Section 4807 (Prior Art Exclusion): 35 U.S.C. 103 was amended in 1984 to exclude subject matter developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) as prior art under 35 U.S.C. 103 against a claimed invention, provided that the subject matter and the claimed invention were commonly owned by the

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same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made. *See* Pub. L. 98–622, § 103, 98 Stat. 3384 (1984). Section 4807 of the American Inventors Protection Act of 1999 amends 35 U.S.C. 103(c) to exclude subject matter developed by another person which qualifies as prior art only under one or more of 35 U.S.C. 102(e), (f), or (g) as prior art under 35 U.S.C. 103 against a claimed invention, provided that the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made. The Office has published guidelines concerning the implementation of this change to 35 U.S.C. 103(c). *See Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term ''Original Application'' in the American Inventors Protection Act of 1999,* 1233 *Off. Gaz. Pat. Office* 54 (Apr. 11, 2000).

Discussion of Specific Rules: The Office is adopting the changes set forth in the Interim Rule to §§ 1.7, 1.17(e) and (i), 1.53(d)(1), 1.78(a)(3), 1.97(b), 1.104(c)(4), 1.113, 1.116, 1.198, 1.312, and 1.313(a), (b), (c)(1), (c)(3), and (d) in this final rule. The Office is adopting revised §§ 1.53(c)(3), 1.103, 1.114, and 1.313(a) and (c)(2) in this final rule.

Title 37 of the Code of Federal Regulations, Part 1, is amended as follows:

Section 1.7 is amended by designating the current text as paragraph (a) and adding a new paragraph (b) to provide that if the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

Section 1.17(e) sets forth the fee to request continued examination pursuant to new § 1.114, which is set at an amount equal to the basic filing fee for a utility application. Therefore, the fee for considering a submission pursuant to § 1.114 is currently $690.00 ($345.00 for a small entity).

Section 1.17(i) is amended to include a reference to the fee to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b), and to eliminate the reference to § 1.312.

Section 1.53 is amended by redesignating paragraph (c)(3) as paragraph (c)(4) and adding a new paragraph (c)(3) to provide for the conversion of a provisional application to a nonprovisional application. Section 1.53(c)(3) provides that a request to convert a provisional application filed under § 1.53(c) to a nonprovisional application under § 1.53(b) must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application otherwise contains at least one claim. Section 1.53(c)(3) also provides that such a request must be filed prior to the earliest of: (1) abandonment of the provisional application; or (2) expiration of twelve months after the filing date of the provisional application.

Section 1.53(c)(3) also provides that the nonprovisional application resulting from conversion of a provisional application must also include the filing fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(e) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application. While this language was not included in interim § 1.53(c)(3), it simply clarifies that once a provisional application is converted into a nonprovisional application, the resulting nonprovisional application must comply with the requirements applicable to nonprovisional applications (*e.g.,* the requirement for the basic filing fee for a nonprovisional application and an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175).

Section 1.53(c)(3) also provides that the conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application.

Finally, § 1.53(c)(3) contains the admonitions that: (1) conversion of a provisional application to a nonprovisional application under § 1.53(c)(3) will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested; and (2) applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to § 1.53(c)(3)).

The conversion of a provisional application to a nonprovisional application will not result in any savings in filing fees over the filing of a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and § 1.78 of the earlier provisional application. Thus, an applicant may simply file a nonprovisional application claiming the benefit under 35 U.S.C. 119(e) and § 1.78 of the earlier provisional application and avoid the fee set forth in § 1.17(i) required to convert a provisional application to a nonprovisional application (as well as the adverse patent term effects discussed above).

Section 1.53(d)(1)(i) is amended to provide that continued prosecution application (CPA) practice under § 1.53(d) does not apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000. Thus, an application (except for a design application) must have an actual filing date before May 29, 2000, for the applicant to be able to file a CPA of that application. While the Office uses the filing date (and application number) of the prior application of a CPA for identification purposes, the filing date of a CPA under § 1.53(d) is the date the request for a CPA is filed. *See* § 1.53(d)(2). Thus, if a CPA of an application (other than for a design patent) is filed on or after May 29, 2000, § 1.53(d)(1)(i) does not permit the filing of a further CPA, regardless of the filing date of the prior application as to the first CPA (*i.e.,* the filing date used for identification purposes for the CPA).

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new § 1.114 (unless the application has issued as a patent). If an applicant files a request for a CPA of an application to which CPA practice no longer applies and does not want the request for a CPA to be treated as a request for continued examination under § 1.114 (*e.g.,* the CPA is a divisional CPA), the applicant may file a petition under § 1.53(e) requesting that the improper CPA be converted to an application under § 1.53(b). The requirements for such a petition under § 1.53(e) are identical to those set forth in section 201.06(b) of the *Manual of Patent Examining Procedure* (7th ed.1998) (Rev. 1, Feb. 2000) (*MPEP*) for converting an improper file wrapper continuing (FWC) application under former § 1.62 to an application under § 1.53(b). The Office will not grant such a petition unless it is before the appropriate deciding official before an Office action has been mailed in response to the request for continued examination under § 1.114 (as the improper CPA is being treated). If an Office action has been mailed in response to the request for continued examination under § 1.114, the applicant should simply file an application under § 1.53(b) within the period for reply to such Office action.

If, however, an applicant files a transmittal paper that is ambiguous as to whether it is a continued prosecution application under § 1.53(d) or a request for continued examination under § 1.114 (*e.g.,* contains references to both an RCE and a CPA), and the application is eligible for either a continued prosecution application under § 1.53(d) or a request for continued examination under § 1.114 (*i.e.,* a plant or utility application filed on or after June 8, 1995, but before May 29, 2000), that ambiguity will be resolved in favor of treating the transmittal papers as a request for a CPA under § 1.53(d). Other papers filed with the transmittal paper (*e.g.,* a preliminary amendment or information disclosure statement) will not be taken into account in determining whether a transmittal paper is a continued prosecution application under § 1.53(d), or a request for continued examination under § 1.114, or ambiguous as to whether it is a continued prosecution application under § 1.53(d) or a request for continued examination under § 1.114.

Section 1.53(d)(1)(ii)(A) is amended to refer to ''§ 1.313(c)'' rather than ''§ 1.313(b)(5)'' for consistency with the change to § 1.313.

Section 1.78 is amended to eliminate the requirement that a nonprovisional application be ''copending'' with a provisional application for the nonprovisional application to claim the benefit under 35 U.S.C. 119(e) of a provisional application. Section 1.78 is also amended to require that, for a nonprovisional application to claim the benefit of a provisional application, the provisional application must be entitled to a filing date as set forth in § 1.53(c), and have paid the basic filing fee set forth in § 1.16(k) within the time period set forth in § 1.53(g), and have any required English language translation filed within the time period set under § 1.52(d).

Section 1.97(b) is amended to indicate that an information disclosure statement will also be considered if it is filed before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

Section 1.103 is amended to provide for a limited suspension of action after a request for continued examination under § 1.114. Section 1.103 is also amended based upon previously proposed changes to that section. *See Changes to Implement the Patent Business Goals,* Notice of Proposed Rulemaking, 64 FR 53772, 53799–00, 53833–34, (Oct. 4, 1999), 1228 *Off. Gaz. Pat. Office* 15, 39–40, 72 (Nov. 2, 1999) (Patent Business Goals Notice of Proposed Rulemaking). These changes are being adopted in this final rule because of the overlap between the provisions for a limited suspension of action after a request for continued examination under § 1.114 and the previously proposed limited suspension of action in a CPA under § 1.53(d).

The heading of § 1.103 is amended to add the phrase ''by the Office'' to clarify that § 1.103 applies only to suspension of action by the Office (by applicant request or at the initiative of the Office) and does not apply to a suspension of action (or reply) by the applicant.

Section 1.103(a) provides for suspension of action for cause. Specifically, § 1.103(a) provides that on request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. Section 1.103(a) also provides that: (1) The Office will not suspend action if reply by applicant to an Office action is outstanding; and (2) any petition for suspension of action under § 1.103(a) must specify a period of suspension not exceeding six months. Section 1.103(a) specifically provides that any petition for suspension of action under § 1.103(a) must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) the fee set forth in § 1.17(h), unless such cause is the fault of the Office.

Section 1.103(b) provides for a limited suspension of action in a CPA filed under § 1.53(d). Section 1.103(b) specifically provides that on request of the applicant, the Office may grant a suspension of action by the Office under § 1.103(b) in a CPA for a period not exceeding three months. Section 1.103(b) also provides that any request for suspension of action under § 1.103(b) must be filed with the request for a CPA and include the processing fee set forth in § 1.17(i).

Section 1.103(c) provides for a limited suspension of action after a request for continued examination under § 1.114. Section 1.103(c) specifically provides that on request of the applicant, the Office may grant a suspension of action by the Office under § 1.103(c) after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Since § 1.103(c) requires a request for continued examination in ''compliance with § 1.114,'' a request for suspension of action under § 1.103(c) does not substitute for the submission (or fee) required by § 1.114. The period of suspension, however, may be used to prepare and file a supplement (*e.g.*, affidavit or declaration containing test data) to the previously filed submission. Section 1.103(c) also provides that any request for suspension of action under § 1.103 must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i). The ability to submit a request for suspension when a request for continued examination under § 1.114 is filed is particularly useful in that its fee (unlike the CPA filing fee) must be paid when the request for continued examination under § 1.114 is filed.

Section 1.103(d) provides that the Office will notify applicant if the Office, on its own initiative, suspends action on an application.

Section 1.103(e) provides for suspension of action for public safety or defense. Section 1.103(e) specifically provides that the Office may suspend action by the Office by order of the Commissioner if the following conditions are met: (1) The application is owned by the United States; (2) publication of the invention may be detrimental to the public safety or defense; and (3) the appropriate department or agency requests such suspension.

Section 1.103(f) provides that the Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under Subpart E.

Section 1.104(c)(4) is revised to replace ''35 U.S.C. 102(f) or (g)'' with ''35 U.S.C. 102(e), (f) or (g)'' for consistency with 35 U.S.C. 103(c) as amended by § 4807 of the American Inventors Protection Act of 1999.

Section 1.113 is amended to take into account that an applicant's after final reply options include filing a request for continued examination under § 1.114. Section 1.113 is also amended to locate the last two sentences of paragraph (a) in a new paragraph (c).

Section 1.114 is added to implement § 4403 of the American Inventors Protection Act of 1999. The Office is providing a procedure under which an applicant may obtain continued examination of an application in which prosecution is closed (*e.g.*, the application is under a final rejection or a notice of allowance) by filing a submission and paying a specified fee. If a subsequent rejection or action is made final (or if the application is subsequently allowed), the applicant may again obtain continued examination of an application (consideration of a submission) upon the filing of a submission and an additional payment of the specified fee prior to abandonment of the application.

Since the relevant portion of § 4405(b)(1) of the American Inventors Protection Act of 1999 (the effective date provision for 35 U.S.C. 132(b)) states that continued examination provisions of 35 U.S.C. 132(b) apply to ''all applications'' filed under 35 U.S.C. 111(a) on or after June 8, 1995, the continued examination provisions of 35 U.S.C. 132(b) and § 1.114 apply to any nonprovisional (35 U.S.C. 111(a)) application filed on or after June 8, 1995, regardless of whether the application is a reissue application or a non-reissue (original) application. The continued examination provisions of 35 U.S.C. 132(b) and § 1.114, however, will not be available for: (1) A provisional application (which is not examined under 35 U.S.C. chapter 12); (2) an application for a utility or plant patent (whether reissue or non-reissue) filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination.

Under this procedure, the filing of a request for continued examination after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal, will be considered a request to withdraw the appeal and to reopen prosecution of the application before the examiner. The filing of a request for continued examination (accompanied by the fee and a submission) after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) or the commencement of a civil action, will also result in the finality of the rejection or action being withdrawn and the submission being considered.

In addition to the *res judicata* effect of a Board of Patent Appeals and Interferences decision in an application (*see MPEP* 706.03(w)), a Board of Patent Appeals and Interferences decision in an application is the ''law of the case,'' and is thus controlling in that application and any subsequent related application. *See MPEP* 1214.01 (where a new ground of rejection is entered by the Board of Patent Appeals and Interferences pursuant to § 1.196(b), argument without either amendment of the claims so rejected or the submission of a showing of facts can only result in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board of Patent Appeals and Interferences). As such, a submission containing arguments without either amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection.

The procedure set forth in § 1.114 will not be available in an application after the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action, unless the appeal or civil action is terminated and the application is still pending. Unless an application contains allowed claims (or the court's mandate clearly indicates that further action is to be taken in the Office), the termination of an unsuccessful court appeal or civil action results in the abandonment of the application. *See MPEP* 1216.01.

If the application is under final rejection, the fee for a request for continued examination acts only to withdraw the finality of an Office action. If reply to an Office action is outstanding, a submission meeting the reply requirements of § 1.111 must be timely received to continue prosecution of an application. Put simply, the mere payment of the fee for a request for continued examination will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. Likewise, filing a request for continued examination (with the fee and a submission) in an allowed application after the issue fee has been paid without a petition under § 1.313 to withdraw the application from issue will not operate to avoid issuance of the application as a patent. Nevertheless, if a request for continued examination (with the fee and a submission) is filed in an allowed application prior to payment of the issue fee, a petition under § 1.313 to withdraw the application from issue is not required.

To avoid confusion as to whether an applicant desires to amend the application prior to receiving continued examination of the application, an appeal brief under § 1.192 or a reply brief under § 1.193(b), or related submissions, are expressly excluded as a submission for the purposes of § 1.114. The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief submitted as a reply to the final rejection, or may simply consist of a submission that incorporates by reference the arguments in a previously filed appeal brief or reply brief.

35 U.S.C. 132(a) provides that ''[n]o amendment shall introduce new matter into the disclosure of the invention.'' Any amendment entered pursuant to § 1.114 that is determined to contain new matter will be treated in the same manner that a reply under § 1.111 that is determined to contain new matter is currently treated. In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure in § 1.114 is not available, and the applicant must file a continuation-in-part application under § 1.53(b) containing such new matter. In addition, as 35 U.S.C. 132(b) and § 1.114 provide continued examination of an application (and not examination of a continuing application), the Office will not permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (*see* § 1.145).

The request for continued examination procedure in § 1.114 should not be confused with the transitional procedure for the further limited examination of patent applications set forth in § 1.129(a) (*see Changes to Implement 20–Year Patent Term and Provisional Applications*, Final Rule Notice, 60 FR 20195 (April 25, 1995), 1174 *Off. Gaz. Pat. Office* 15 (May 2, 1995)) or the CPA procedure set forth in § 1.53(d) (*see Changes to Patent Practice and Procedure*, Final Rule Notice, 62 FR 53131 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* 63 (October 21, 1997)).

Comparison of the request for continued examination procedure in § 1.114 with the transitional procedure for the further limited examination of patent application set forth in § 1.129(a): The procedure set forth in this notice does not apply to any application that was filed prior to June 8, 1995. The transitional procedure set forth in § 1.129(a) applies only to applications, other than for a reissue or design patent, that have been pending for at least two years as of June 8, 1995, taking into account any references in such applications to any earlier filed application under 35 U.S.C. 120, 121, or 365(c), and is not applicable to any application filed after June 8, 1995. Therefore, an application eligible for the transitional procedure set forth in § 1.129(a) (unless filed on June 8, 1995), or any application filed before June 8, 1995, is not eligible for the procedure for continued examination set forth in this notice.

In addition, an applicant in an application eligible for the procedure for continued examination set forth in this notice is not limited in the number of times the fee for continued examination may be submitted. An applicant in an application eligible for the transitional procedure set forth in § 1.129(a), however, is limited to two opportunities to pay the fee for further examination of the application.

Moreover, under the transitional procedure set forth in § 1.129(a), a submission after final rejection or action will be considered if the submission and the requisite fee are filed prior to abandonment of the application and prior to the filing of an appeal brief. Under the request for continued examination procedure set forth in this notice, a submission will be considered if the submission and the requisite fee is filed prior to abandonment of the application. That is, under the request for continued examination procedure, a submission (and requisite fee) need not be filed prior to the filing of an appeal brief. In addition, under the request for continued examination procedure, a submission will be considered in an allowed application if the submission and the requisite fee are filed prior to payment of the issue fee (or later if a petition under § 1.313(c) to withdraw the application from issue is granted).

Comparison of the request for continued examination procedure in § 1.114 with the CPA procedure set forth in § 1.53(d): Section 1.53(d) is amended to make CPA practice inapplicable to applications (other than for a design patent) filed under 35 U.S.C. 111(a) on or after May 29, 2000, or resulting from international applications filed under 35 U.S.C. 363 on or after May 29, 2000. Continued prosecution application (CPA) practice was adopted to permit applicants to obtain continued examination of an application (for a fee) via the filing of a continuing application. 35 U.S.C. 132(b), however, provides statutory authority for the Office to prescribe regulations to permit applicants to obtain continued examination of an application (for a fee) without the need for a continuing application. The Office is not completely abolishing CPA practice in favor of the request for continued examination practice in § 1.114 because the request for continued examination practice in § 1.114 is not applicable to applications filed before June 8, 1995 (or design applications), and the patent term adjustment provisions of Pub. L. 106–113 do not apply to applications filed before May 29, 2000. The Office, however, is restricting CPA practice to utility and plant applications filed before May 29, 2000, and design applications because maintaining two practices (as to applications eligible for the continued examination procedure of § 1.114) designed for the same purpose (obtaining continued examination of an application) is unnecessary and will result in confusion.

Since the request for continued examination practice in § 1.114 is applicable to utility and plant applications filed on or after June 8, 1995, and CPA practice in § 1.53(d) is applicable to utility and plant applications filed before May 29, 2000, and design applications, an applicant in a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, may obtain further examination either by filing a request for continued examination under § 1.114 or by filing a CPA under § 1.53(d). Since the patent term adjustment provisions of Pub. L. 106–113 do not apply to applications filed before May 29, 2000, and a request for continued examination practice under § 1.114 (unlike a CPA under § 1.53(d)) is not the filing of a new application, whether further examination of such an application is sought by a request for continued examination under § 1.114 or a CPA under § 1.53(d) has an impact on whether any resulting patent is entitled to the patent term adjustment provisions of Pub. L. 106–113. Specifically, if an applicant in a utility or plant application filed before May 29, 2000, files a CPA under § 1.53(d) after May 29, 2000, the application being prosecuted (now a CPA) is an application filed on or after May 29, 2000, and is entitled to the patent term adjustment provisions of Pub. L. 106–113. If, however, an applicant in a utility or plant application filed before May 29, 2000 (but on or after June 8, 1995) files a request for continued examination under § 1.114, the application being prosecuted is not an application filed on or after May 29, 2000, and is not entitled to the patent term adjustment provisions of Pub. L. 106–113.

In addition, there are a number of additional differences between request for continued examination procedure set forth in this notice with the CPA procedure set forth in § 1.53(d) resulting from the fact that a CPA is the filing of a new application, whereas continued examination under § 1.114 merely continues the examination of the same application: (1) A request for continued examination under § 1.114 is not permitted unless prosecution in the application is closed (*cf.* § 1.53(d)(1)); (2) the fee for continued examination under § 1.114 (§ 1.17(e)) does not have an additional claims fee component (*cf.* 1.53(d)(3)(ii)); (3) the fee for continued examination under § 1.114 may not be deferred (*cf.* § 1.53(f)); (4) a request for continued examination under § 1.114 is entitled to the benefit of a certificate of mailing under § 1.8 (*cf.* 1.8(a)(2)(i)(A)); (5) an applicant may not obtain examination of a different or non-elected invention (*e.g.,* a divisional) in a request for continued examination under § 1.114; and (6) any change of inventors must be via the procedure set forth in § 1.48 (*cf.* 1.53(d)(4)).

Discussion of the specific provisions of new § 1.114: Section 1.114 is added to provide for continued examination of an application under 35 U.S.C. 132(b).

Section 1.114(a) provides that if prosecution in an application is closed, an applicant may obtain continued examination of an application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of: (1) Payment of the issue fee, unless a petition under § 1.313 is granted; (2) abandonment of the application; or (3) the filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated. The action immediately subsequent to the filing of a submission and fee under § 1.114 may be made final only if the conditions set forth in *MPEP* 706.07(b) for making a first action final in a continuing application are met.

Interim § 1.114 did not require that prosecution in an application be closed for an applicant to obtain continued examination under that section, but only that the Office had mailed at least one of an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. There is, however, no benefit (from applicant's perspective) to requesting continued examination under § 1.114 if prosecution in the application is not closed. Thus, any request for continued examination under § 1.114 in an application in which prosecution is not closed would probably have been filed in error. In addition, the legislative history of 35 U.S.C. 132(b) reveals that its continued examination provisions were designed for applications in which prosecution was closed. *See* 145 Cong. Rec. S.14708, S.14718 (daily ed. November 17, 1999) (statement of Sen. Lott); *see also* H.R. Rep. No. 106–464 at 128 (1999). Therefore, the Office considers it inappropriate to permit (or encourage) applicants to request and pay the fee for continued examination under 35 U.S.C. 132(b) and § 1.114 unless prosecution in the application is closed.

Section 1.114(b) provides that prosecution in an application is closed as used in § 1.114 means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application (*e.g.,* an Office action under *Ex parte Quayle,* 1935 Comm'r Dec. 11 (1935)).

Section 1.114(c) provides that a submission as used in § 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. This definition in § 1.114 for ''submission'' is taken from § 1.129(a). Section 1.114(c) also provides that if reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111. This provision will permit applicants to file a submission under § 1.114 containing only an information disclosure statement (§§ 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. 151.

Section 1.114(d) provides that if an applicant timely files the fee set forth in § 1.17(e) and a submission, the Office will withdraw the finality of any Office action to which a reply is outstanding and the submission will be entered and considered. The phrase ''withdraw the finality of any Office action'' includes the withdrawal of the finality of a final rejection, as well as the withdrawal of the closing of prosecution by an Office action under *Ex parte Quayle,* 1935 Comm'r Dec. 11 (1935), or notice of allowance under 35 U.S.C. 151 (or notice of allowability). Section 1.114(d) also provides that if an applicant files a request for continued examination under § 1.114 after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. Thus, the filing of a request for continued examination under § 1.114 in an application containing an appeal awaiting decision after appeal will be treated as a withdrawal of the appeal by the applicant, regardless of whether the request for continued examination under § 1.114 includes the appropriate fee (§ 1.17(e)) or a submission (§ 1.114(c)). Applicants should advise the Board of Patent Appeals and Interferences when a request for continued examination under § 1.114 is filed in an application containing an appeal awaiting decision. Otherwise, the Board of Patent Appeals and Interferences may refuse to vacate a decision rendered after the filing (but before recognition by the Office) of a request for continued examination under § 1.114. Section 1.114(d) also provides that an appeal brief or a reply brief (or related papers) will not be considered a submission under § 1.114 (discussed above).

Section 1.114(e) provides that the request for continued examination provisions of § 1.114 do not apply to: (1) A provisional application; (2) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) an international application filed under 35 U.S.C. 363 before June 8, 1995; (4) an application for a design patent; or (5) a patent under reexamination.

Section 1.116 is amended to add a paragraph (a) that takes into account that an applicant's after final amendment options include filing a request for continued examination under § 1.114, and to redesignate existing paragraphs (a), (b), and (c) as paragraphs (b), (c), and (d), respectively.

Section 1.198 is amended to take into account that an application in which an appeal has been decided by the Board of Patent Appeals and Interferences may also be reopened under the request for continued examination provisions of § 1.114.

Section 1.312 is amended by clarifying that an amendment under § 1.312 (after allowance) must be filed prior to or with payment of the issue fee.

Section 1.313(a) is being amended to provide that it is not necessary to file a petition to withdraw an application from issue if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If an applicant files a request for continued examination under § 1.114 (with the fee and a submission) prior to the date the issue fee is due, the applicant need not pay the issue fee to avoid abandonment of the application. Applicants are cautioned against filing a request for continued examination under § 1.114 prior to payment of the issue fee and subsequently paying the issue fee (before the Office acts on the request for continued examination under § 1.114) because doing so may result in issuance of a patent without consideration of the request for continued examination under § 1.114 (if the request for continued examination under § 1.114 is not matched with the application before the application is processed into a patent).

Section 1.313(c) is amended to provide that an application may also be withdrawn from issue after payment of the issue fee on petition by the applicant for consideration of a request for continued examination in compliance with § 1.114. This language differs from the language of interim § 1.313(c)(2), but the change simply clarifies the requirements for an application to be withdrawn from issue under § 1.313(c)(2).

The Office cannot ensure that any petition under § 1.313(c) will be acted upon prior to the date of patent grant. *See Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee,* Notice, 1221 *Off. Gaz. Pat. Office* 14 (April 6, 1999). Since a request for continued examination under § 1.114 (unlike a CPA under § 1.53(d)) is not any type of new application filing, the Office cannot grant a petition to convert an untimely request for continued examination under § 1.114 to a continuing application under § 1.53(b). Therefore, applicants are strongly cautioned to file any desired request for continued examination under § 1.114 prior to payment of the issue fee. In addition, applicants considering filing a request for continued examination under § 1.114 after payment of the issue fee are strongly cautioned to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider (and grant) a petition under § 1.313(c) and what steps are needed to ensure that a grantable petition under § 1.313(c) is before an appropriate official in the Office of Petitions in sufficient time to grant the petition before the patent is issued. Finally, applicants filing a request for continued examination under § 1.114 after allowance but prior to payment of the issue fee are cautioned against subsequently paying the issue fee because doing so may result in the prompt issuance of a patent.

Response to comments: The Office received fifteen written comments (from Intellectual Property Organizations, Law Firms, Patent Practitioners, and others) in response to the Interim Rule. Comments generally in support of a change are not discussed. The comments and the Office's responses to those comments (as well as the comments on the proposed change to § 1.103 in the Patent Business Goals Notice of Proposed Rulemaking) follow:

Comment 1: One comment suggested that simply applying the basic filing fee as the fee for continued examination under 35 U.S.C. 132(b) and § 1.114 was inappropriate, as the Office does not need to conduct any pre-examination processing when an applicant requests continued examination under 35 U.S.C. 132(b) and § 1.114.

Response: The basic filing fee does not recover the Office's costs of pre-examination processing and examination of an application; rather, this cost is recovered in part by the issue fee and maintenance fees. The actual cost to the Office (in the aggregate) of providing the examination required by 35 U.S.C. 131 and 132(a) exceeds the basic filing fee. Thus, the basic filing fee for a utility application is considered an ''appropriate'' fee within the meaning of 35 U.S.C. 132(b).

Comment 2: One comment (while acknowledging that the issue was not a rulemaking issue) requested that the Office clarify the impact of the changes to 35 U.S.C. 119(e) to: (1) Remove the copendency requirement for a nonprovisional application to claim the benefit of a provisional application; and (2) extend the period of pendency of a provisional application if the date that is twelve months after the filing date of a provisional application falls on Saturday, Sunday, or a Federal holiday within the District of Columbia.

Response: Prior to enactment of the American Inventors Protection Act of 1999, a nonprovisional application claiming the benefit of a provisional application under 35 U.S.C. 119(e) must have been: (1) Filed not later than within twelve months after the filing date of the provisional application; and (2) filed during the pendency of the provisional application. Section 4801 of the American Inventors Protection Act of 1999 amended 35 U.S.C. 119(e) to eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional application, but did not change the requirement that a nonprovisional application claiming the benefit of a provisional application be filed not later than within twelve months after the filing date of the provisional application.

The provisions of 35 U.S.C. 21(b) extend the twelve-month period in 35 U.S.C. 119(e)(1) to the next succeeding secular or business day if the last day of that twelve-month period falls on a Saturday, Sunday, or Federal holiday. *See Dubost* v. *U.S. Patent and Trademark Office,* 777 F.2d 1561, 1562, 227 USPQ 977, 977 (Fed. Cir. 1985), and *Ex parte Olah,* 131 USPQ 41, 42–43 (Bd. Pat. App. 1961). The reason for the caveat in former § 1.78(a)(3) is that: (1) 35 U.S.C. 119(e)(2) formerly required that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional application; and (2) 35 U.S.C. 111(b)(5) provides that a provisional application will become abandoned twelve months after its filing date regardless of what action is taken or fee is paid in such provisional application. Thus, the provisions of 35 U.S.C. 21(b) do not appear to extend the twelve-month period in 35 U.S.C. 111(b)(5) to the next succeeding secular or business day if the last day of that twelve-month period falls on a Saturday, Sunday, or Federal holiday. The American Inventors Protection Act of 1999 amended 35 U.S.C. 119 to: (1) Eliminate the requirement that a nonprovisional application claiming the benefit of a provisional application must have been filed during the pendency of the provisional application (35 U.S.C. 119(e)(2)); and (2) extend the twelve-month period in 35 U.S.C. 111(b)(5) to the next succeeding secular or business day if the last day of that twelve-month period falls on a Saturday, Sunday, or Federal holiday (35 U.S.C. 119(e)(3)).

The provision extending the period of pendency of a provisional application if the date that is twelve months after the filing date of a provisional application falls on Saturday, Sunday, or a Federal holiday within the District of Columbia is still relevant (notwithstanding the elimination of the requirement that a nonprovisional application claiming the benefit of a provisional application has been filed during the pendency of the provisional application) as § 1.53(c)(3) requires that any request to convert a provisional application into a nonprovisional application be filed prior to abandonment of the provisional application.

Comment 3: One comment suggested that the Office provide (as a default) that a provisional application is abandoned as of its filing date.

Response: The rules of practice (§ 1.138) allow an applicant to file a letter of express abandonment in any application (including a provisional application). The applicant is in the best position to determine whether a provisional application should remain pending until twelve months from its filing date or whether it should be abandoned (expressly or otherwise) prior to that date. For example, an applicant may wish to maintain the pendency of the provisional application so that it can be converted under 35 U.S.C. 111(b)(5) and § 1.53(c)(3) into a nonprovisional application (§ 1.53(c)(3)(i)). Therefore, the Office considers it inappropriate to provide for abandonment of a provisional application as of its filing date as a default.

Comment 4: One comment suggested that the Office not require a translation of a non-English language provisional application. The comment argued that: (1) The patent statute does not permit the Office to deny a filing date to a non-English language provisional application if a translation is not provided; (2) provisional applications do not need to be in English since they are never examined; (3) requiring a translation for every non-English language provisional application requires more paper handling by the Office; (4) requiring a translation in every non-English language provisional application discriminates against foreign applicants and discourages foreign applicants from filing provisional applications in the United States; and (5) requiring a translation in every non-English language provisional application is not necessary for national security screening. Another comment suggested that the Office not require a translation of a non-English language provisional application if the provisional application discloses an invention made outside the United States.

Response: The rules of practice do not require an English language translation of a non-English language provisional (or nonprovisional) application as a condition of according a filing date to the application. The Office has proposed to revise the rules of practice to require an English language translation of a non-English language provisional application when the benefit of the filing date of the provisional application is claimed in a later-filed nonprovisional application, and then the English language translation of the provisional application will be required to be filed only in the nonprovisional application. *See Changes to Implement Eighteen-Month Publication of Patent Applications,* Notice of Proposed Rulemaking, 65 FR 17946, 17953, 17965 (Apr. 5, 2000), 1233 *Off. Gaz. Pat. Office* 121, 127, 137 (Apr. 25, 2000). Since the effective prior art (35 U.S.C. 102(e)) date of a patent takes claims under 35 U.S.C. 119(e) for the benefit of a provisional application's filing date into account, but does not take claims under 35 U.S.C. 119(a)–(d) for the benefit of a foreign application's filing date into account, the Office has a reasonable basis for having different requirements for provisional application claims under 35 U.S.C. 119(e) than for foreign application claims under 35 U.S.C.

119(a)–(d). Obviously, if a non-English-language provisional application is converted under 35 U.S.C. 111(b)(5) and § 1.53(c)(3) into a nonprovisional application, an English language translation will be required in the resulting nonprovisional application.

Comment 5: One comment suggested that § 1.53(c)(3) contain a sentence that advises applicants that conversion of a provisional application under § 1.53(c)(3) results in a forfeiture of rights under 35 U.S.C. 119, and that the term of any patent which issues from the application will be measured from the initial filing date of the provisional application.

Response: Section 1.53(c)(3) as adopted will caution applicants that conversion of a provisional application to a nonprovisional application under § 1.53(c)(3) will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Section 1.53(c)(3) will also provide that applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to § 1.53(c)(3)).

Comment 6: One comment suggested that § 1.53(c)(3) provide that upon conversion of a provisional application to a nonprovisional application, the nonprovisional application should be accorded a filing date as of the date on which a request for conversion of provisional application to a nonprovisional application was filed, but that the original filing date of the provisional application should be preserved. The comment also requested clarification on the order in which a nonprovisional application resulting from conversion of a provisional application will be taken up for examination.

Response: If an applicant files a provisional application and subsequently requests that the provisional application be converted into (or treated as) a nonprovisional application (and that request is granted), there remains only a single (now nonprovisional) application. For the Office to accord the resulting nonprovisional application a filing date as of the date on which a request for conversion of provisional application to a nonprovisional application was filed, but somehow preserve the original filing date of the provisional application, would require the Office to accord two filing dates to a single application. There is nothing in the legislative history of § 4801 of the American Inventors Protection Act of 1999 indicating that Congress intended an application filing scheme under which a single application would be both a provisional application with one filing date and a nonprovisional application with a different filing date. Rather, it appears that § 4801 of the American Inventors Protection Act of 1999 simply permits an applicant who previously filed a provisional application to have a ‘‘change of heart’’ and subsequently have the application treated as (or converted to) a nonprovisional application. This change also lays to rest the argument that a provisional application is not a proper priority application under Article 4 of the Paris Convention for the Protection of Industrial Property because a provisional application cannot result in a U.S. patent (since a provisional application can now be converted into a nonprovisional application, which can result in a U.S. patent). *See* 1180 *Off. Gaz. Pat. Office* 131 (Nov. 28, 1995).

The Office plans to take up a nonprovisional application resulting from conversion of a provisional application for examination based upon the filing date of the request for conversion under § 1.53(c)(3) (rather than the filing date of the resulting nonprovisional application). This will preserve parity among applicants filing a nonprovisional application claiming the benefit of an earlier provisional application and applicants requesting conversion of a provisional application into a nonprovisional application pursuant to § 1.53(c)(3).

Comment 7: One comment suggested that § 1.53(c)(3) be amended to provide that if a provisional application does not contain a claim, and a claim was not filed with a request to convert the application into a nonprovisional application, the Office will notify the applicant and set a time period for submitting a claim for examination.

Response: The Office does not consider it appropriate to convert a provisional application into a nonprovisional application until at least one claim is present. Thus, § 1.53(c)(3) requires the presence of at least one claim before the Office will grant a request to convert a provisional application into a nonprovisional application. If a provisional application does not contain a claim, and a claim is not filed with a request to convert the application into a nonprovisional application, the Office will set a time period within which a claim must be submitted for the Office to grant the request to convert the provisional application into a nonprovisional application.

Comment 8: Several comments stated that the twelve-month period specified in § 1.53(c)(3)(ii) does not take into account the pendency extension provided in § 1.7(b).

Response: The twelve-month period set forth in § 1.53(c)(3)(ii) concerning when a request to convert a provisional application into a nonprovisional application must be filed does not relate to the pendency of the provisional application, but the twelve-month period within which any nonprovisional application claiming the benefit of that provisional application must be filed. *See* 35 U.S.C. 119(e)(1). As discussed above, if the last day of the twelve-month period set forth in § 1.53(c)(3)(ii) falls on a Saturday, Sunday, or Federal holiday, that period is extended to the next succeeding secular or business day by 35 U.S.C. 21(a) (and § 1.7(a)).

Comment 9: One comment indicated that if an applicant fails to timely reply to a Notice to File Missing Parts of Application in a provisional application, the Office should permit an applicant to revive the provisional application to file the filing fee, surcharge, translation, or whatever else is missing from the provisional application such that a nonprovisional application may claim the benefit of the provisional application under 35 U.S.C. 119(e) and § 1.78.

Response: Section 1.78(a)(3) requires, for a nonprovisional application to claim the benefit of a provisional application, that the provisional application filing fee be paid within the period specified in § 1.53(g), and that any English language translation be filed within the period specified in § 1.52(d). Thus, the grant of a petition to revive the provisional application will still not result in compliance with § 1.78(a)(3). Rather, the applicant would be required to file a petition under § 1.183 showing that circumstances of applicant's failure to pay the provisional application filing fee within the period specified in § 1.53(g), or failure to file any English language translation within the period specified in § 1.52(d), constitutes an ‘‘extraordinary situation’’ in which ‘‘justice requires’’ a waiver of this requirement of § 1.78(a)(3). The Office has proposed revising the rules of practice as to when an English language translation of a non-English language provisional is required, as well as the condition under which an untimely English language translation will be accepted. *See Changes to Implement Eighteen-Month Publication of Patent*

Applications, 65 FR at 17953, 17965, 1233 *Off. Gaz. Pat. Office* at 127, 137.

Comment 10: Several comments argued that the Office should retain CPA practice under § 1.53(d) as to divisional applications, since an applicant is not permitted to switch inventions under the request for continued examination practice set forth in § 1.114.

Response: CPA practice under § 1.53(d) was adopted in December of 1997 (during fiscal year 1998). *See Changes to Patent Practice and Procedure,* 62 FR at 53186–87, 1203 *Off. Gaz. Pat. Office* at 111–12. The purpose of CPA practice was to provide a mechanism (via the filing of a continuing application) for applicants to obtain further examination of an application for a fee (to which the small entity reduction in 35 U.S.C. 41(h) applies) in the absence of express statutory authority for the Office to provide further or continued examination of an application for a fee (to which the small entity reduction applies). *See Changes to Patent Practice and Procedure,* 62 FR at 53142, 1203 *Off. Gaz. Pat. Office* at 72. 35 U.S.C. 132(b) now provides express statutory authority for the Office to provide further or continued examination of an application for a fee (to which the small entity reduction applies). Therefore, CPA practice may now be considered a ''transitional practice'' relative to the request for continued examination practice set forth in 35 U.S.C. 132(b), and the Office is retaining CPA practice only as to applications filed before the effective date of request for continued examination practice set forth in 35 U.S.C. 132(b) (May 29, 2000) and design applications.

Divisional CPAs make up only a small percentage of divisional applications or CPAs. In fiscal year 1998, the Office received about 12,000 divisional applications and about 18,000 CPAs, about 400 of which were divisional CPAs. In fiscal year 1999, the Office received about 14,000 divisional applications and about 26,000 CPAs, about 300 of which were divisional CPAs. Thus, divisional CPAs made up about three percent of all divisional applications and about two percent of all CPAs filed in fiscal year 1998, and made up about two percent of all divisional applications and about one percent of all CPAs filed in fiscal year 1999.

Divisional CPAs, however, have a much higher than average frequency of filing date petitions (over ten times higher) than other types of applications. Almost always, the filing error resulting in the need for a filing date petition is that the applicant has filed a divisional application as a CPA (usually with a copy of the specification, drawings, and oath or declaration from the prior application) when the applicant meant to file a divisional application under § 1.53(b). The petition to convert the divisional CPA into a divisional application under § 1.53(b) usually cannot be granted because it is relatively rare that the petition is filed (much less brought before an appropriate deciding official) before the prior application is abandoned as a result of being processed into a CPA. *See Continued Prosecution Application (CPA) Practice*, Notice, 1214 *Off. Gaz. Pat. Office* 32, 32 (Sept. 8, 1998). In view of the relatively low number of divisional CPAs and the frequency of filing errors involving divisional CPAs, the divisional CPA has proven itself to be the bane of CPA practice. Thus, the elimination of divisional CPA practice appears to be a benefit (rather than a drawback) to eliminating CPA practice for applications (other than designs) filed on or after May 29, 2000.

In any event, retaining CPA practice as to ''divisional'' CPAs and eliminating it as to ''continuation'' CPAs is not practical. The expressions ''continuation,'' ''divisional,'' and ''continuation-in-part'' are merely terms used for administrative convenience. *See Transco Products, Inc.* v. *Performance Contracting, Inc.*, 38 F.3d 551, 556, 32 USPQ2d 1077 (Fed. Cir. 1994). Thus, providing that a CPA must be a ''divisional'' CPA rather than a ''continuation'' CPA would be meaningless, as it would only require that an applicant filing a CPA label the CPA as a ''divisional'' CPA.

Section 1.53(d)(1) restricts CPA practice to ''continuation'' and ''divisional'' CPAs (*i.e.*, does not permit continuation-in-part CPAs) through the requirement that a CPA disclose and claim only subject matter disclosed in the prior application. *See* § 1.53(d)(2)(ii). While § 1.53(d) could be amended to further restrict CPA practice to ''divisional'' applications that claim only subject matter disclosed but not elected for examination in the prior application, such a provision would require a restriction-type analysis to determine whether a CPA is proper under this revised CPA practice. Retaining CPA practice for the few divisional CPAs filed each year does not justify the complexity that such a provision would introduce into application filing procedures.

Finally, any utility or plant CPA filed on or after November 29, 2000, is subject to the eighteen-month publication provisions of the American Inventors Protection Act of 1999. The Office's planning approach to eighteen-month publication involves obtaining application papers (a specification), drawings, an oath or declaration, and any sequence listing (if required) necessary for the eighteen-month publication process during the pre-examination processing of the application in the Office of Initial Patent Examination (OIPE). *See Changes to Implement Eighteen-Month Publication of Patent Applications*, Notice of Proposed Rulemaking, 65 FR 17046, 17948–49 (Apr. 5, 2000), 1233 *Off. Gaz. Pat. Office* 121, 122–23 (Apr. 25, 2000). Since the Office does not conduct any pre-examination processing of a CPA in OIPE, the Office's Patent Application Capture and Review (PACR) database will probably not have the application papers (a specification), drawings, an oath or declaration, and any sequence listing (if required) necessary for the eighteen-month publication process. Restricting CPA practice to the situation in which the prior utility or plant application was filed before May 29, 2000, will limit the number of utility or plant CPAs filed on or after November 29, 2000, each of which will require special handling to obtain the application papers (a specification), drawings, an oath or declaration, and any sequence listing (if required) necessary for the eighteen-month publication process.

Comment 11: One comment suggested that § 1.97(b) be revised to provide that an information disclosure statement will be considered if it is filed within three months after the date of a request for continued examination under § 1.114.

Response: Since a request for continued examination is a reply under 35 U.S.C. 132, the applicant may be entitled to patent term adjustment if the Office does not act on an application containing a request for continued examination under § 1.114 within four months. *See* 35 U.S.C. 154(b)(1)(A)(ii). Thus, the Office cannot delay the acting on all applications in which a request for continued examination under § 1.114 is filed for three months to determine whether an information disclosure statement will be filed. The Office, however, is adopting provisions (under § 1.103(c)) for a limited suspension of action after the filing of a request for continued examination under § 1.114, under which an applicant may obtain additional time (prior to the issuance of the next Office action) to provide an information disclosure statement (or amendments, or an affidavit or declaration) after the filing of the request for continued examination.

Comment 12: One comment suggested that the Office clarify its statement that § 1.103 does not apply to requests for suspension of action by the applicant in an application.

Response: The Office is distinguishing a request from applicant for the Office to suspend action by the Office from a request from applicant to suspend action by applicant to an outstanding Office requirement. Section 1.103 applies only to a request by applicant for the Office to suspend action by the Office in an application. Section 1.103 does not apply to a request by applicant to suspend action (reply) by the applicant in an application.

Comment 13: One comment suggested that the three-month suspension period for CPAs should be available simply upon request without any associated fee, or a lower CPA filing fee is justified as an offset. The comment argued that there is no rational basis for payment of an additional fee simply to have the CPA obtain the same benefit of filing a preliminary amendment or information disclosure statement (IDS) as an application under § 1.53(b) (non-CPA), since the filing fees for both are the same.

Response: The comment is not adopted. Section 1.53(d) (CPA practice) was established to provide applicants with a means for promptly receiving continued examination of an application under final rejection via the filing of a continuing application. The normal expectation for a CPA is that a first Office action will issue before any preliminary amendment or IDS can be submitted if the preliminary amendment or IDS is not already prepared when the CPA is filed. In these situations, applicants have relied upon not paying the filing fee for the CPA and thereby requiring the Office to mail a Notice to File Missing Parts of Application (requiring a payment of a surcharge). Section 1.103(b) now permits applicants to avoid the practice of not paying the filing fee, and to alert the Office that submission of a preliminary amendment or IDS is being contemplated (§ 1.103(b) does not require a statement of reason for the suspension request or actual submission of anything). The processing fee required for a request for suspension of action under § 1.103(b) is to recover the costs for: (1) Treating the application and the preliminary amendment or IDS separately rather than being able to treat them together when the application is filed; and (2) for redocketing of the application so that a first Office action is delayed.

Comment 14: One comment questioned the applicability of the exclusion in 35 U.S.C. 103(c) if the subject matter and claimed invention were jointly owned by two or more companies and subject to assignment to both (*i.e.*, whether ''person'' and ''organization'' are interpreted as including joint ownership by multiple persons or organizations).

Response: The terms ''person'' and ''organization'' in 35 U.S.C. 103(c) and § 1.104(a)(5) include the situation in which ownership resides in more than one person or organization, provided that the applications are owned jointly by the same owners. *See MPEP* 706.02(I)(2).

Comment 15: One comment asked whether the amendment to § 1.104(c)(4) applied to applications filed on or after November 29, 1999.

Response: The amendment to 35 U.S.C. 103(c) in § 4807 of the American Inventors Protection Act of 1999 applies to any application for patent filed on or after November 29, 1999. Therefore, the corresponding amendment to § 1.104(c)(4) applies to any application for patent filed on or after November 29, 1999.

Comment 16: One comment asked whether a CPA under § 1.53(d) filed on or after November 29, 1999, is an application for patent filed on or after November 29, 1999, such that the amendment to 35 U.S.C. 103(c) in § 4807 of the American Inventors Protection Act of 1999 applies to the CPA.

Response: A CPA under § 1.53(d) filed on or after November 29, 1999, is an application for patent filed on or after November 29, 1999 (regardless of the filing date of the prior application), such that the amendment to 35 U.S.C. 103(c) in § 4807 of the American Inventors Protection Act of 1999 applies to the CPA.

Comment 17: One comment suggested that design applications not be excluded from the request for continued examination practice set forth in § 1.114, which would permit continued prosecution application practice (under § 1.53(d)) to be completely phased out within a few years.

Response: Section 4405(b)(2) of the American Inventors Protection Act of 1999 excludes design applications from the request for continued examination practice set forth in 35 U.S.C. 132(b) and § 1.114.

Comment 18: Several comments suggested that § 1.114 should indicate that the first action after filing a request for continued examination may not be a final rejection.

Response: The first action after the filing of a request for continued examination under § 1.114 may be made final, but only if the conditions set forth in *MPEP* 706.07(b) for making a first action final in a continuing application are met. This practice (first action final practice) denies an applicant the delay inherent in an additional Office action in a continuation application, thus compelling the applicant to draft claims in a continuation application in view of the prosecution history of the parent application (*i.e.*, the rejections and prior art of record in the parent application), and thus make a *bona fide* effort to define the issues for appeal or allowance. *In re Bogese*, 22 USPQ2d 1821, 1824–25 Comm'r Pat. 1992). The Office's need for applicants to make a bona fide effort to define the issues for appeal or allowance when filing a request for continued examination under § 1.114 remains, notwithstanding the changes to the patent term provisions of 35 U.S.C. 154 contained in the Uruguay Round Agreements Act (URAA), Pub. L. 103–465, 108 Stat. 4809 (1994).

Comment 19: One comment stated that under 35 U.S.C. 132(a) an applicant is entitled to persist in his or her claim to a patent, with or without amendment, and that an applicant is likewise entitled to request continued examination under 35 U.S.C. 132(b) ''with or without amendment.'' The comment argues that § 1.113 is inconsistent with 35 U.S.C. 132 in that it requires an applicant to appeal or amend to obtain further consideration of the application.

Response: The second examination (or ''reexamination'') provision of 35 U.S.C. 132(a) is implemented in § 1.112, which does not require the applicant to amend the application. The continued examination provision of 35 U.S.C. 132(b) is implemented in § 1.114, which again does not require the applicant to amend the application to obtain continued examination (a submission ''includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability'').

Section 1.113 applies to applications under a final rejection or action, which occurs after the Office has satisfied its obligation to examine (35 U.S.C. 131) and reexamine (35 U.S.C. 132(a)) the application. Former and current § 1.113 limits the applicant's after final options to appeal from or cancellation of the rejected claims. Since the Office is not required by 35 U.S.C. 132 to provide continued examination of an application under final rejection or action (regardless of whether the applicant amends) unless the applicant requests (and pays the fee for) continued examination under 35 U.S.C. 132(b) and § 1.114, the Office is not required by 35 U.S.C. 132 to give applicants after final options other than appeal, cancellation of the rejected claims, or continued examination under § 1.114.

Comment 20: Several comments suggested that § 1.114 provide that if a request for continued examination under § 1.114 is accompanied by the fee but not a submission, the Office will notify the applicant and set a time period within which the deficiency must be corrected. One comment also suggested that § 1.114 provide that if a request for continued examination under § 1.114 is filed after an application is allowed, and is accompanied by the fee but not a submission, the Office will notify the applicant and set a time period within which the deficiency must be corrected.

Response: The Office will not suspend action in an application when a reply by the applicant is outstanding. 35 U.S.C. 133 requires an applicant to ''prosecute the application'' within six months of an Office action (or a shorter period as set in the Office action) to avoid abandonment of the application. If an applicant files a request for continued examination but does not also provide any submission (in reply to the prior Office action) within the period for reply to the prior Office action, the application is abandoned by operation of law (35 U.S.C. 133). Providing a different practice for the relatively few applications in which a request for continued examination under § 1.114 is filed after a notice of allowance has been issued would be a trap for the unwary if relied upon in an application subject to an Office action under 35 U.S.C. 132.

The Office will treat a request for continued examination under § 1.114 containing a *bona fide* submission that is not fully responsive to the prior Office action under the practice set forth in § 1.135(c). In addition, under the limited suspension of action provisions of § 1.103(c), an applicant must still file a request for continued examination practice in compliance with § 1.114, but may obtain additional time (prior to the issuance of the next Office action) to provide an information disclosure statement, amendments, or an affidavit or declaration after the filing of the request for continued examination.

Comment 21: Several comments suggest that the Office permit applicants to submit an amendment canceling previously examined claims and presenting claims to a previously non-elected invention (*i.e.*, ''switch inventions'') when filing a request for continued examination under § 1.114.

Response: The Office does not consider it appropriate to permit an applicant to accumulate patent term adjustment under 35 U.S.C. 154(b) on the basis of the examination of a first elected invention and to apply that patent term adjustment to a patent on a subsequently elected (previously non-elected) invention. If the Office permits applicants to submit an amendment canceling previously examined claims and presenting claims to a previously non-elected invention when filing a request for continued examination under § 1.114, the applicant will be able to accumulate patent term adjustment under 35 U.S.C. 154(b) on the basis of the examination of a first elected invention and to apply that patent term adjustment to a patent on a subsequently elected (previously non-elected) invention. Thus, an applicant may not obtain examination of a different or non-elected invention (*e.g.*, a divisional) in a request for continued examination under § 1.114.

Comment 22: Several comments suggested that § 1.116 should continue to permit entry of an amendment after final rejection upon a showing of good and sufficient reasons why the amendment is necessary and was not presented earlier.

Response: Section 1.116(c) permits entry of an amendment after final rejection upon a showing of good and sufficient reasons why the amendment is necessary and was not presented earlier.

Comment 23: One comment noted that § 1.85(c) permitted applicants to file corrected drawings after payment of the issue fee, and questioned how minor amendments to the specification (for consistency with the corrected drawings) may be filed after payment of the issue fee in view of the changes to §§ 1.312 and 1.313.

Response: Section 1.85 will be amended to provide that the three-month period set in notice of allowability for submission of any outstanding corrected or formal drawings is not extendable under § 1.136(a) or (b). Thus, any corrected or formal drawings (and conforming amendments to the specification) should be submitted on or before the date the issue fee is paid.

Comment 24: One comment suggested that the Office must allow for amendments after payment of the issue fee because the Office often does not rule on an amendment under § 1.312 submitted prior to payment of the issue fee until after the period for payment of the issue fee has expired.

Response: Section 1.312 is not intended to be used for continued examination of an application. *See MPEP* 714.16. Any amendments considered necessary by the applicant should be completed before a notice of allowance is issued in the application. Applicants should not be submitting a series of amendments after issuance of a notice of allowance to determine what changes the examiner will permit under § 1.312.

Comment 25: One comment suggested that § 1.313(a) be amended to state that an application may be withdrawn from issue prior to payment of the issue fee for consideration of a request for continued examination under § 1.114. The comment argued that an applicant should not be forced to pay the issue fee while waiting to see whether an application will be withdrawn from issue to consider a request for continued examination under § 1.114.

Response: Section 1.313(a) is being amended to provide that it is not necessary to file a petition to withdraw an application from issue if a request for continued examination under § 1.114 is filed prior to payment of the issue fee.

Comment 26: One comment suggested that a grantable petition under § 1.313(c) to withdraw an application from issue be considered effective on the filing date of the petition, rather than on the date an Office official acts on the petition.

Response: The withdrawal of an application from issue after payment of the issue fee is not considered a ministerial act; rather, the Office will withdraw an application from issue only when the Office determines that the conditions specified in §§ 1.313(b) or 1.313(c) are satisfied. See *Harley* v. *Lehman*, 981 F. Supp. 9, 44 USPQ2d 1699 (D.D.C. 1997). Therefore, the Office does not consider it appropriate to consider a petition to withdraw an application from issue after payment of the issue fee to be effective on the filing date of the petition.

Classification

Administrative Procedure Act: The changes in this final rule concern only the manner by which an applicant obtains continued examination of a nonprovisional application, requests conversion of a provisional application into a nonprovisional application, or claims the benefit of a provisional application, as provided for in §§ 4403 and 4801 of the American Inventors Protection Act of 1999 (Title IV of S. 1948, incorporated into Pub. L. 106–113). Therefore, prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553(b)(A) (or any other law), and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law).

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), the analytical requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are inapplicable.

Executive Order 13132: This final rule does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

Executive Order 12866: This final rule has been determined to be not significant for purposes of Executive Order 12866 (September 30, 1993).

Paperwork Reduction Act: This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under the following control numbers: 0651–0031, 0651–0032, and 0651–0033. The United States Patent and Trademark Office is not resubmitting information collection packages to OMB for its review and approval because the changes in this final rule do not affect the information collection requirements associated with the information collections under these OMB control numbers.

The title, description, and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impact of the changes in this final rule is to implement the changes to Office practice necessitated by §§ 4403, 4801, and 4807 of the American Inventors Protection Act of 1999.

OMB Number: 0651–0031.
Title: Patent Processing (Updating).
Form Numbers: PTO/SB/08/21–27/30/31/42/43/61/62/63/64/67/68/91/92/96/97.
Type of Review: Approved through October of 2002.
Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.
Estimated Number of Respondents: 2,231,365.
Estimated Time Per Response: 0.46 hours.
Estimated Total Annual Burden Hours: 1,018,736 hours.
Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments, Petitions and their Transmittal Letters; and Deposit Account Order Forms.

OMB Number: 0651–0032.
Title: Initial Patent Application.
Form Number: PTO/SB/01–07/13PCT/17–19/29/101–110.
Type of Review: Approved through October of 2002.
Affected Public: Individuals or Households, Business or Other For-Profit, Not-for-Profit Institutions and Federal Government.
Estimated Number of Respondents: 334,100.
Estimated Time Per Response: 8.95 hours.
Estimated Total Annual Burden Hours: 2,990,260 hours.
Needs and Uses: The purpose of this information collection is to permit the United States Patent and Trademark Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the United States Patent and Trademark Office in processing and examination of the application.

OMB Number: 0651–0033.
Title: Post Allowance and Refiling.
Form Numbers: PTO/SB/13/14/44/50–57; PTOL–85b.
Type of Review: Approved through September of 2000.
Affected Public: Individuals or Households, Business or Other For-Profit, Not-for-Profit Institutions and Federal Government.
Estimated Number of Respondents: 135,250.
Estimated Time Per Response: 0.325 hour.
Estimated Total Annual Burden Hours: 43,893 hours.
Needs and Uses: This collection of information is required to administer the patent laws pursuant to title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, DC 20231, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503, (Attn: Desk Officer for the United States Patent and Trademark Office).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, the interim rule amending 37 CFR Part 1 which was published at 65 FR 14865–14873 on March 20, 2000, is adopted as final with the following changes:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.53 is amended by revising paragraph (c)(3) to read as follows:

§ 1.53 Application number, filing date, and completion of application.

* * * * *

(c) * * *

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C. 112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(e) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.,* the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under this paragraph (c).

* * * * *

3. Section 1.103 is revised to read as follows:

§ 1.103 Suspension of action by the Office.

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d).* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Limited suspension of action after a request for continued examination (RCE) under § 1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(d) *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(e) *Suspension of action for public safety or defense.* The Office may suspend action by the Office by order of the Commissioner if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

(f) *Statutory invention registration.* The Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under Subpart E of this part.

4. Section 1.114 is revised to read as follows:

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

5. Section 1.313 is amended by revising paragraphs (a) and (c)(2) to read as follows:

§ 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

* * * * *

(c) * * *

(2) Consideration of a request for continued examination in compliance with § 1.114; or

* * * * *

Dated: August 9, 2000.

Q. Todd Dickinson,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 00–20744 Filed 8–15–00; 8:45 am]

BILLING CODE 3510–16–P